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(s)

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Linda S. Evans

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Dubin et al.

Atty. Docket: ORT-1601

Serial No.: 10/090,215

Art Unit: 1646

Filed: March 4, 2002

Examiner: Prema Maria Mertz

For: DNA ENCODING HUMAN
VANILLOID RECEPTOR VR3

Confirmation No.: 5197

Mail Stop Non-Fee Amendments
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action mailed September 2, 2004, Applicant submits the following remarks for consideration. In the event any fees are required for the filing of this response, including in connection with any necessary extension of time (for which Applicant hereby petitions), please charge such fees to Deposit Account No. 10-0750.

In the outstanding Office Action, the Examiner set forth a requirement under 35 U.S.C. § 121 restricting Applicant to one of the following inventions: (I) claims 1-9 and 14, drawn to a nucleic acid encoding the protein of SEQ ID NO:7, a vector, a host cell, and a method of producing the protein; (II) claims 1-9 and 14, drawn to a nucleic acid encoding the protein of SEQ ID NO:9, a vector, a host cell, and a method of producing the protein; (III) claims 1-9 and 14, drawn to a nucleic acid encoding the protein of SEQ ID NO:12, a

vector, a host cell, and a method of producing the protein; (IV) claims 10 and 11, drawn to protein comprising SEQ ID NO:7; (V) claims 10 and 11, drawn to protein comprising SEQ ID NO:9; (VI) claims 10 and 11, drawn to protein comprising SEQ ID NO:12; (VII) claims 12 and 13, drawn to an antibody to the protein set forth in SEQ ID NO:7; (VIII) claims 12 and 13, drawn to an antibody to the protein set forth in SEQ ID NO:9; (IX) claims 12 and 13, drawn to an antibody to the protein set forth in SEQ ID NO:12; (X) claims 15-17, drawn to a method for identifying compounds that modulate human VR3 receptor protein activity; (XI) claims 18-21, drawn to a compound that modulates human VR3 receptor protein activity; and (XII) claim 22, drawn to a method of treatment by administering a compound that modulates human VR3 receptor protein activity.

Applicant hereby elects Group VI, claims 10 and 11, directed to a protein comprising SEQ ID NO:12. This election is without traverse with respect to the restriction requirement between the elected group and each of Groups I, II, III, VII, VIII, IX, X, XI, and XII. The election is with traverse, however, with respect to the restriction requirement between each of Groups IV-VI as well as between each of Groups I-III and between each of Groups VII-IX for the reasons discussed below.

Applicant respectfully submits that the claims of Groups IV and V should be rejoined with the claims of Group VI. Likewise, the claims of Groups I-III should be considered together and the claims of Groups IV-VI should be considered together. All groups of claims in each of these sets should be rejoined because their consideration together would not impose a serious burden on the Examiner.

For a restriction requirement to be proper, both of the following criteria must be met: (i) the inventions must be independent or distinct as claimed; and (ii) the consideration of the inventions as claimed in the same application must impose a serious burden on the Examiner. See M.P.E.P. § 803. Here, although the groups of invention are independent and distinct, the second criterion has not been met as evidenced by the Examiner's common classification of the claims for Groups I-III, Groups IV-VI, and Groups VII-IX. Accordingly, the restriction requirement is improper to the extent it fails to join the

claims of Groups I-III together, the claims of Groups IV-VI together, and the claims of Groups VII-IX together.

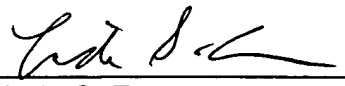
Furthermore, the requirement is improper to the extent it calls in several instances for restriction within a single claimed Markush group. To the extent the requirement calls for an election of a species encompassed by a genus recited in one claim, Applicant understands the requirement to constitute an election-of-species requirement. Thus, Applicant elects the species of protein represented by SEQ ID NO: 12. Claims 10 and 11 read on the elected species. Since only three species of amino acid sequences are recited in the Markush group defined in claim 11, the number of species is sufficiently small and the species are sufficiently related, as reflected by their common search classification, such that they should be examined together in the present application. See M.P.E.P. § 803.02. See also M.P.E.P. § 803.04 (noting that "it has been determined that normally ten sequences constitute a reasonable number for examination purposes").

Accordingly, Applicant requests rejoinder of the claims of Groups IV and V with elected Group VI, and examination on the merits of the claims in these groups in the present application.

Respectfully submitted,

Date: October 4, 2004

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